



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP AF
Franklin C. Simon et al.)	
Application No.: 10/804,299)	Group Art Unit: 3629
Filed: March 19, 2004)	Examiner: MICHAEL J. FISHER
For: TIME-BASED DISABLEMENT OF)	Confirmation No.: 7817
EQUIPMENT)	
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejections in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal and two month Petition for Extension of Time.

Applicants respectfully submit that the current record does not provide a sufficient basis on which to proceed with the Appeal.

Rejection Under 35 U.S.C. §103(a) does not disclose or suggest all claim elements

Claims 1-28, 33-36, and 40-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Joao (U.S. 5,917,405) in view of Walker (U.S. 6,647,328). The final Office Action states that Joao discloses generating a reference code (first signal, claim 1).

However, the Joao reference fails to disclose the claimed method of enabling and disabling a vehicle in response to payments being timely made for the following

reason. The first signal of Joao claim 1 actually is the signal for activating, deactivating, enabling and disabling the vehicle. (See Joao claim 1). The first signal is generated in response to the second signal transmitted from a second control device which in turn is responsive to a third control device, both of which are remote from the vehicle and from one another. The first signal is not a reference code as recited in the claims.

The system described in Joao's claim 1 does not recite a comparator, but the Office asserts that it is inherent in a system that receives signals. The Office Action does not provide any factual basis or line of technical reasoning to support the allegedly inherent characteristic that must necessarily flow from the Joao patent. *Ex parte Levy* 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990).

Assuming, *arguendo*, that the first signal is a reference signal, the alleged additional code input via the keypad 975 would have to be the second or third signal recited in Joao's claim 1. Joao's claim 1 does not state that the first signal and either of the second or third signals are compared to one another and disabling a vehicle if the codes do not match. The keypad 975 shown in Figure 11a of the Joao patent is shown in the central security office and not at the equipment or vehicle. Joao does not state that either the second or third signal is received via a keypad at the vehicle as recited in Applicants' independent claims 1, 3, 12, 14, 18, 20, 25, 33, 41 and 45.

As for independent claim 19, the Examiner admits at page 5 of the Office Action that the Joao patent does not disclose computing at least one deadline.

The Walker reference does not overcome the deficiencies of the Joao patent. The Examiner asserts that Walker teaches a vehicle disabling system, that is "useful for loan companies". However, Applicants respectfully note that the cited portions of

Walker fail to disclose or suggest computing a payment due deadline or generating or using codes corresponding to the deadline.

Claim 12 recites a means for periodically receiving a code corresponding to a payment deadline. The Office Action states that entering a code, via a keypad (975) is periodic (it is shown as being entered more than once, thus this would be "periodically".) However, the plain meaning of "periodically" is having or marked by repeated cycles or happening or appearing at regular intervals (American Heritage College Dictionaries, 3rd Edition, (1993) p. 1016). Inputting an additional code more than once does not meet the plain meaning of "periodically". Therefore, for at least this reason, claim 12 is allowable.

Finally, independent claim 45 recites an additional feature of wherein said computing a payment due deadline step is performed in an initialization process where a host computing apparatus is connected to a client computing apparatus, the host computing apparatus providing the client computing apparatus with a database including a plurality of payment due deadline data elements and reference codes, and wherein said method repeats steps a-h using each of the plurality of payment due deadline data elements and reference codes. The Office Action does not address this feature. Therefore, the rejection of claim 45 should be withdrawn. For at least the above reasons, the rejection of claims 1-28, 33-36 and 40-45 should be withdrawn.

Lack of Motivation to Combine Teachings of Joao with Walker

In the motivational statement for combining Joao with Walker in the rejections of claims 1-28, 33-36, and 40-45, the Office Action states that it would have been obvious to one of ordinary skill in the to use a payment deadline as this is one the

loan company would require payment in accordance with a loan agreement or repossess the vehicle, and to change the codes for future deadlines else a code for a past deadline could be used for a future deadline. As for claims 2, 28 and 36, the Office Action alleges that it is very well known in the art for loan companies to have a so-called "grace-period" in their loan repayment schedule. However, there is no such suggestion in either the Joao patent or the Walker patent for such a combination and neither patent suggest that either system suffers from such deficiencies.

The Office Action appears to rely on the ordinary skill of an artisan. However, the level of those skilled in the art cannot be relied upon to provide the suggestion to combine the references. *Al-Sit Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Seiderman patent does not cure deficiencies of Joao and Walker

As for claims 29-32 and 37-39, these claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Joao in view of Walker as applied to claims 1-28 and 30-45 above and further in view of Seiderman (U.S. 5,850,599). The Seiderman patent is directed to a portable cellular telephone with credit card debit systems. However, the citation to claim 1 of the Seiderman patent does not cure the above noted deficiencies in the Joao and Walker patents. Seiderman does not disclose or suggest all of the features recited in the independent claims. The citation to the background section of Seiderman merely gives an overview of the prior art as allowing a user to input an emergency number and complete the 911 telephone call. Therefore, it is respectfully submitted that the Seiderman patent does not cure the deficiencies of the Joao and Walker patents as described above.

In addition, as motivation for modifying the Joao patent and the Walker patent, for allowing an emergency number to activate the system as taught by Seiderman, the Office Action states if the car is disabled in a dangerous place, and the user is hurt, the person could sue the loan company. It is unclear where such motivation to combine the teachings of the Joao, Walker or Seiderman is found in any of the patents. Therefore, it is respectfully submitted that the above combination does not disclose all of the features of the independent claims and, therefore, withdrawal of the rejections of claims 1-45 is respectfully requested.

Conclusion


Accordingly, Applicants respectfully request that the final Office Action be withdrawn, and that all claims be allowed, or prosecution be reopened to establish a proper record for appeal. A Terminal Disclaimer will be filed when there is an indication of allowable subject matter.

Respectfully submitted,

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